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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

UNS-103-B

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Application Number

10/692,442

Filed

10/23/2003

First Named Inventor

Whittaker

Art Unit

3635

Examiner

Gilbert, William V.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 55,886


Signature

Craig A. Redinger

Typed or printed name

(734) 662-0270

Telephone number

August 4, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE: Whittaker

Serial No.: 10/692,442

Group No.: 3635

Filing Date: October 23, 2003

Examiner: Gilbert, William V.

For: **APPARATUS FOR ISOLATING AND LEVELING A MACHINE
FOUNDATION****PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

These remarks are being filed along with a Pre-Appeal Brief Request for Review and Notice of Appeal, along with the requisite fees. This paper is responsive to the Advisory Action dated July 6, 2009. The Pre-Appeal Brief Request for Review is based upon clear legal error and/or factual deficiencies and not based on the interpretation of claims or prior art teachings.

Applicant submits that the Examiner has failed to make a legally-sufficient rejection under 35 U.S.C. §102(b) in regard to independent claims 1 and 9, as well as their respective dependent claims. As stated in §2131 of the MPEP, not only must a prior art reference teach every element of the claim, the reference must also show those elements arranged as required by the claim.

The Examiner has applied a rationale to many of the elements of claims 1 and 9 that ignores the arrangement of the elements in those claims. In several instances, the Examiner has

aggregated multiple structure from a prior art reference and then applied those elements to a single claim element. While this type of aggregation is not improper, it must be applied consistently. Where the claim element in question is claimed as meeting several structural and functional limitations, it is not proper to identify multiple structures as constituting that element and then apply those structures individually to meet the limitations of the claim, where the cited structure, as a whole, does not read on the claim limitations.

As an example, with regard to claim 1, the Examiner identified a frame member 240 and an intermediate support means 250 of Cristy as the claimed upper portion of an enclosure, while identifying a circular plate 230 and diaphragm 232 as a lower portion of the claimed enclosure. The Examiner concluded that this structure meets the limitation of claim 1 that requires that the upper portion of the enclosure be telescopically adjustably connected to the lower portion of the enclosure, citing a telescopic connection of the frame member 240 and the intermediate support means 250. However, Cristy clearly shows that the frame member 250 of Cristy is bolted to the circular plate 230 in a facing, non-telescopic manner. Applicant submits that both of the elements identified as an upper portion of the enclosure, namely, the frame member 240 and the intermediate support means 250, would need to be telescopically adjustably connected to the circular plate 230 and the circular diaphragm 232 to properly meet the claim language. The Examiner's finding that this limitation is met based on a part of the identified structure meeting the limitation disregards the arrangement of the elements specified in the claim and constitutes clear error.

Other examples of this erroneous reasoning are present with regard to the following claim

limitations (all page references herein are to the Request for Reconsideration dated June 1, 2009):

- The rigid enclosure in claims 1 and 9 (pages 3, 13).
- Telescopically connected enclosure portions in claims 1 and 9 (pages 5-7, 13).
- Means for rigidly connecting in claim 1 (pages 7-8).
- The upper and lower enclosure portions being substantially tubular and having open ends in claim 21 (pages 10-11).
- The upper portion of the enclosure being fabricated as an integral body in claim 22 (pages 11-12).
- A plurality of fasteners that connect a bearing member to an anchor ring in a vertically-spaced relationship for vertical adjustment in claim 9 (pages 13-15).
- A support member in contact with a bearing member and engageable with a substructure in claim 9 (page 15).

In each of these cases, the elements identified by the Examiner are not arranged as required in the claims. Accordingly, Applicant submits that the finding of anticipation regarding claims 1 and 9 and their dependent claims is clearly erroneous.

Applicant also submits that the rejection of claim 24 is improper in that the Examiner's finding with respect to this element is not supported by substantial evidence. In particular, in the Office Action dated March 30, 2009, the Examiner identified a labeled character "X" in a figure shown on page 3 of the Action as an inner perimeter of a ring having fasteners (labeled "C") around the inner perimeter. The label "X" clearly points to the outer perimeter of a circular flange. Since this finding is not supported by substantial evidence, the rejection is in clear error.

For the foregoing reasons, Applicant requests review of the Final Office Action dated March 30, 2009 because the Examiner has failed to make a legally-sufficient anticipation rejection under 35 U.S.C. §102(b) of at least claims 1, 9 and 24 for the reasons discussed above.

If there are any questions or comments regarding this matter, Applicant's undersigned counsel may be reached at (734) 662-0270 or by electronic mail at redinger@youngbasile.com.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Craig A. Redinger", written over a horizontal line.

Craig A. Redinger
Reg. No. 55,886

Dated: August 4, 2009